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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/769,466	01/26/2001	Hiroshi Matsuda	35.C15057	5463
5514	7590	06/10/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			PHAM, THIERRY L	
			ART UNIT	PAPER NUMBER
			2624	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/769,466	MATSUDA, HIROSHI	
	Examiner	Art Unit	
	Thierry L. Pham	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM
 THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 24 January 2005.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-97 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

- This action is responsive to the following communication: an Amendment filed on 1/24/2005.
- Claims 1-97 are pending in application; Claims 16-97 are newly added.
- Amendment to the specification filed on 1/24/2005 has been received and entered.
- Amendment to the Title filed on 1/24/05 has been received and entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide an adequate written description of the limitations as recited in claims 1-97, wherein “allotted outputting mode so that output processing of the input data is allotted to the plural image output devices”; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. The examiner is unclear what the applicant is referring to as “allotted outputting mode”. Nowhere within an original filed specification, an “allotted outputting mode” can be found. Herein, the examiner interprets “allotted outputting mode” as “print mode” as shown in fig. 12a, which taught by Owa.

Claims 16-97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The

specification does not provide an adequate written description of the limitations as recited in newly added claims 16-97, wherein “controller inhibits an execution of the allotted printing operation”; therefore, it does not enable one skilled in the art to make, use and/or practice the invention. The examiner is unclear what the applicant is referring to as “inhibiting an execution of the allotted printing operation”. Nowhere within an original filed specification, a controller for “inhibiting an execution of the allotted printing operation”. Herein, the examiner interprets “inhibiting an execution of the allotted printing operation” as “printer that does not meet user’s requested attribute is excluded” as taught by Owa”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Owa et al (U.S. 6348971).

Regarding claim 1, Owa discloses an image output control apparatus (host computer, fig. 1) connected to plural image output devices (plurality of printers, fig. 1) through communication media, capable of controlling to output images of predetermined input data using the plural image output devices (host computer for controlling plurality of printers that are connected via a communication network, fig. 1), comprising:

- mode select means (print mode selection screen, fig. 12a) for selecting an allotted outputting mode (i.e. fast and/or normal print mode, fig. 12a) so that output processing of the input data is allotted to the plural image output devices (print data with selected mode will be routed to printer with selected attribute, col. 12, lines 55-67);

- selection means (printer selection means, fig. 7) for selecting the plural image output devices that should be used in the allotted outputting mode (monochrome pages of document print by the printer 31c and color pages of document print by printer 31a, fig. 7);
- obtaining means (basic information setting section 12 of fig. 2 and printer state management means for obtaining conditions of plurality of printers, fig. 7 and col. 3, lines 50+) for obtaining output media information (i.e., paper size and type of each printers, figs. 3-4 and 9a) stored in each the image output device of the plural image output devices that are selected to be used in the allotted outputting mode;
- judgment means (printer information retention means for retaining/judging printer information, figs. 3-4, 9-15, col. 18, lines 18-24) judging whether or not the plural image output devices selected to be used in the allotted outputting mode store the same-sized output media (i.e. fig. 9a shows plurality of different printers with different sized output media and/or same sized media, A4/A3/B4, fig. 9a) on the basis of the output media information obtained by said obtaining means; and
- notification means (notifying and transmitting printer's information via a communication network, fig. 2 and figs. 3-4, cols. 4-6 and col. 12, lines 1-5) for notifying of a judgment result obtained by said judgment means.

Regarding claim 2, Owa further discloses an apparatus according to claim 1, further comprising a display for displaying information regarding the image output devices, and said notification means displays a warning message (warning message, col. 5, lines 8-25 and col. 6, lines 50-60) on the display when said judgment means judged that the plural image output devices selected by said selection means do not have the same-sized output media (figs. 3-4, col. 6, lines 50-65).

Regarding claim 3, Owa further discloses an apparatus according to claim 2, wherein it is controlled to cancel selection (CANCEL button, fig. 12b) to be executed by said selection means when said judgment means judged that the plural image output devices selected by said selection means do not have the same-sized output media.

Regarding claim 4, Owa further discloses an apparatus according to claim 1, wherein said judgment means judges whether or not the plural image output devices selected by said selection means have the same-sized and the same-kind output media (paper size and type, col. 4, lines 15-40) on the basis of the output media information.

Regarding claim 5, Owa further discloses an apparatus according to claim 4, further comprising a display for displaying information regarding the image output devices (figs. 3-4), and said notification means displays a warning message on the display when said judgment means judged that the plural image output devices selected by said selection means do not have the same-sized and the same-kind output media (col. 5, lines 8-25 and col. 6, lines 50-60).

Regarding claim 6, Owa further discloses an apparatus according to claim 5, wherein it is controlled to cancel selection (CANCEL button, fig. 12b) to be executed by said selection means when said judgment means judged that the plural image output devices selected by said selection means do not have the same-sized and the same-kind output media.

Regarding claim 7, Owa further discloses an apparatus according to of claim 1, further comprising input means (print data generation section, fig. 2) for inputting image data obtained by reading originals, and it is possible to control that the plural image output devices can output images of image data inputted by said input means.

Regarding claims 8-14: Claims 8-14 are the method claims corresponding to the apparatus claims 1-7 (respectively). The method claims are inherent and included by the operation of the apparatus claims. Please see claims rejection basis/rationale as described in claims 1-7 above.

Regarding claim 15: Claim 15 corresponds to claims 1-7 and/or combination thereof except computer readable memory medium for storing program is claimed rather than printing system or data output apparatus. All computers have some type of computer readable memory medium (storage section, fig. 8) for storing computer program, hence claim 15 would be rejected using the same rationale as in claims 1-7 and/or combination thereof.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owa et al (US 6348971), and in view of Idehara (US 2001/0052995).

Regarding claim 16, Owa discloses an image output system (image output system, fig. 1) comprising:

- plural image output device (plurality of printers, fig. 1);
- each of said plural image output devices comprising :
- a memory unit (storage section 68, fig. 8) adapted to store a plurality of data;
- a printer unit (print engine 66, fig. 8) adapted to perform print processing of data stored in aid memory unit to an output medium;

Owa also teaches a host device for detecting and obtaining paper media type and size of each (figs. 3-4) image output device connected via a network and a controller inhibits an execution (printer that does not meet user's requested attribute is excluded, col. 7, lines 23-40) of the allotted printing operation that uses a different output medium in each of said local device and said other image output device, before the instruction is accepted, when the same output medium is not set in both said local device and said other image output device, but fails to each output device comprising:

- an acceptor adapted to accept an instruction for causing a local device and another image output device to start an allotted printing operation that print processing of a series of data is able to allot to said local device and said other image output device, from a user; and
- a controller adapted to permit an execution of the allotted printing operation in said local device and said other image output device, according to the instruction from the user, when the same output medium is set in both of said local device and said other image output device.

Idehara, in the same field of endeavor for image output system (fig. 1), teaches each output device (copy machine 43, fig. 34) comprising:

- an acceptor (a control panel 431 for accepting instruction from users, fig. 34) adapted to accept an instruction for causing a local device (i.e. copy machine 43, fig. 34) and another image output device (external apparatus 432 including plurality of other copy machines as shown in fig. 36-37) to start an allotted printing operation (print data can be also printed by different copy machines, fig. 36-37, par. 168-205) that print processing of a series of data is able to allot to said local device and said other image output device, from a user; and
- a controller (each copy machine includes a CPU 410 for controlling execution instruction entered by users, fig. 33) adapted to permit an execution of the allotted printing operation in said local device and said other image output device (output print data to different external apparatus including copy machines, host computer, fax machine, server, and etc, figs. 34-38), according to the instruction from the user;

It would have been obvious to one of ordinary skill in the art at the time of the invention was made by modifying image output system of Owa to include an image output device to include an acceptor adapted to accept instruction for causing local and other image output device to allot printing operation and a controller adapted to permit an execution of allotted printing operation as taught by Idehara (in other words, Owa teaches a host computer for selecting different printers for routing the print data/job rather than locally at the copy machine; Idehara teaches a print job can be generated at a copy machine and transmits to different external apparatuses including fax machine, copy

machine, host computer, sever, and etc, and please notes that Idehara also teaches a host computer that routes a print job to different printers, copy machine, fax machine, server, and etc based upon user's specified criteria) because of a following reason: (•) allowing operators/users to copy a print job locally and/or transmit to different external apparatuses (i.e. different copy machine), by doing so, it enhances the flexibility of the printing system and to increase output production (i.e. a print job with 100 pages can be cut in half by using two copy machines).

Therefore, it would have been obvious to combine Owa with Idehara to obtain the invention as specified in claim 16.

Regarding claim 17, Owa further discloses a system according to claim 16, wherein said controller inhibits (printer that does not meet user's requested attribute is excluded, col. 7, lines 23-40) said execution of said allotted printing operation before the instruction from the user is accepted, by controlling beforehand said acceptor so as not to accept the instruction from the user, when the same output medium (different print medias, fig. 3) is not set in both of said local device (local printer 5, fig. 2) and said other image output device (network printer 2a-2c, fig. 2).

Regarding claim 18, Owa further discloses a system according to claim 16, wherein the instruction is accepted via a user interface unit including a display unit (display screen, fig. 12b) used for said image output device, wherein said controller inhibits the execution of the allotted printing operation before the instruction from the user is accepted (display options before executing printing, fig. 12b), by controlling a display of said display unit so as not to accept the instruction, when same output medium is not set in both of said local device and said other image output device. Also see Idehara's control panel (fig. 34) for display unit.

Regarding claims 19-20, Idehara further reaches a system according to claim 16, wherein each of said plural image output devices includes an original image reading unit (scanner unit 416, fig. 33).

Regarding claim 21, Idehara further teaches a system according to claim 16, wherein each of said plural image output devices includes an obtaining unit (obtaining information of different apparatuses connected via a network, fig. 36-38) adapted to obtain information of the other image output devices, and wherein said controller discriminates the output medium using the information obtained by said obtaining unit.

Regarding claims 21-97 recite limitations that are similar and in the same scope of invention as to those in claims 16-21 above; therefore, claims 21-97 are rejected for the same rejection rationale/basis as described in claims 16-21.

Response to Arguments

Applicant's arguments filed 1/24/05 have been fully considered but they are not persuasive.

- Regarding claims 1-15, the applicant argued the cited prior art of record (US 6348971 to Owa) fails to teach and/or suggest selection means for selecting an allotted outputting mode.

In response, the examiner notes that such limitations are not previously cited in claims 1-15 and do not support by the original filed specification, please see 112, 2nd paragraph rejection above for more details. However, upon further consideration, the examiner finds that Owa explicitly teaches a mode select means (print mode selection screen, fig. 12a) for selecting an allotted outputting mode (i.e. fast and/or normal print mode, fig. 12a) so that output processing of the input data is allotted to the plural image output devices (print data with selected mode will be routed to printer with selected attribute, col. 12, lines 55-67).

- Claims 16-97 are newly added and are rejected as being unpatentable over Owa et al (US 6348971), and in view of Idehara (US 2001/0052995). Please see claims 16-21 above for more details.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thierry L. Pham whose telephone number is (571) 2727439. The examiner can normally be reached on M-F (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thierry L. Pham

-TH



GABRIEL GARCIA
PRIMARY EXAMINER